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09/811,466	03/20/2001	Masanobu Kanazawa	122.1445	7961

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EXAMINER

PARDO, THUY N

ART UNIT	PAPER NUMBER
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2165

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/811,466

Applicant(s)

KANAZAWA, MASANOBU

Examiner

Thuy N. Pardo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE and Amendment filed on 12/06/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 06, 2006 has been entered.

2. In Applicant's Amendment filed on December 06, 2006, claims January 18, 2007 in response to the Examiner's Office Action has been reviewed. Claims 6 and 9-15 are pending in the application. Claims 1-5, 7 and 8 have been canceled, and claim 6 has been amended. This office Action is Non-Final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,790,785 to Klug et al. (Hereinafter "Klug") in view of US Patent No. 6,496,855 to Hunt et al. (Hereinafter "Hunt").

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Referring to claim 1, Klug discloses a membership management method in a membership management system as claimed. See Figures 1-8 and the corresponding portions of Klug's specification for this disclosure. In particular, Klug teaches "a membership management system [Fig. 1] comprising:

at least one apparatus [WWW Client Node 108] connected via a network [WWW 104];
a database [148] held by each of a plurality of service provision sites [Third Party Web Sites 116]; and

a database [144] held by an integrated membership management center [Registrar Web Site 100], wherein when a user makes an application [Steps 404-408] for a registration of membership information [User Registration Information] at one of the service provision sites [See Step 404] by using said apparatus, the one of the service provision sites receiving the application registers [Steps 432-436] at least a part of the membership information into the database [148] held by the one of the service provision sites first [See column 5, lines 7-12], and then when the user is not registered [Fig. 4] in the database [144] held by the integrated membership management center, the membership information of the user is subsequently transferred to the integrated membership management center registers [Step 428 (See Figs. 2-3)] the membership information of the user into [Step 236] the database [144] held by the integrated membership management center, wherein the membership information comprises a user ID and a password [See Abstract, Summary of the Invention, & Figures 4-8] and the integrated membership management center allows the user to use a same user ID and password throughout the service provision sites [See Abstract and Summary of the Invention, specifically column 2, lines 2-19]" as claimed.

Klug does not expressly state that the new membership information corresponds to an application for membership completed by a user at one of the service provision sites to obtain access to the one of the service provision sites as claimed. However, Klug's searching unit is specifically configured for determining if the user's registration information specific to a third party web site is different from / not present in the central database, and for registering this new information in the central database.

Hunt discloses a web registration system and method similar to that of Klug, wherein when a user is already registered at a third party web site ("an application for membership completed by a user at one of the service provision sites to obtain access to the one of the service provision sites"), the user's registration information is automatically transferred [See Step 302] to the central registration database [RAS] as claimed. See Figure 5 and the corresponding portion of Hunt's specification for this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Hunt's transfer capabilities to the system and method of Klug, for allowing the user to register at the third party web site and then transferring this new registration information to the central registration database, for example when Klug's search unit determines that registration information for the third party web site is different from, or not already present in, the central registration database [144] to obtain the invention as claimed. One would have been motivated to do so in order to allow the user to automatically transfer information already registered at a third party site to the central database without having to re-type this information at the central site, as disclosed by Hunt.

Referring to claim 2, Klug discloses a membership management system as claimed. Again, see Figures 1-8 and the corresponding portions of Klug's specification for this disclosure. In particular, Klug teaches "a membership management system [Figure 1] comprising: at least one apparatus [WWW Client Node 108] connected via a network [WWW 104]; a database [148] held by each of a plurality of service provision sites [Third Party Web Sites 116]; and a database [144] held by an integrated membership management center [Registrar Web Site 100], wherein each service provision site comprises:

- a membership registration guidance display unit [registration fill-out forms] requesting a user to register membership information at the service provision site [See Steps 408-428];

- a guide unit guiding the user to obtain from the at least one apparatus [the user submits the registration information] the membership information that has been input from the apparatus based on a guidance of the membership registration guidance display unit [See Steps 216-220 and 432];

- a requesting unit requesting the integrated membership management center to register the membership information [See Step 424];

- a unit obtaining [See Step 800] from the integrated membership management center the information about whether the requested membership information has already been registered in the integrated membership management center or whether the integrated membership management center has registered the requested membership information as new registration [See Figs. 4-6 & 8]; and

- a post unit posting to the at least one apparatus a user ID and a password, which are authenticated by the integrated membership management center [See Fig. 2B (Steps 240-256)]

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allowing the user to use the same user ID and password throughout the service provision sites [See Claim 1 above]" as claimed.

Referring to claim 3, Klug discloses the membership management system as claimed. See the discussion regarding claim 2 above for the details of this disclosure. In particular, Klug teaches the membership management system according to claim 2, as above, "wherein the integrated membership management center comprises:

a search unit searching for a record that coincides with user information when receiving from a service provision site a request for registering membership information [See Step 800];

a unit preparing the user ID and the password and adding the user ID and the password to a database when there is no record that coincides with the requested registration membership information as a result of the search [See Steps 236-256];

an adder adding a service qualification to the user to enable the user to receive services from the service provision site when there is a record that coincides with the requested registration membership information as a result of the search [See Steps 432-440]; and

a post unit posting the user ID and the password authenticated by the integrated membership management center to the service provision site [See Step 432]" as claimed.

Referring to claim 4, Klug discloses the membership management system as claimed. See the discussion regarding claim 2 above for the details of this disclosure. In particular, Klug teaches the membership management system according to claim 2, as above, "wherein the membership registration guidance display unit [See the discussion regarding claim 2 above] requests the user to input items of membership information for the integrated membership

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management center [See Figs. 2-3] even if the input items of information are not necessary for the service provision site [See Figs. 4-8]" as claimed.

Claim 7 is rejected on the same basis as claim 4. See the discussions regarding claims 2 and 4 above for the details of this disclosure.

Claims 8-10 and 13 are rejected on the same basis as claims 2-4 and 7 respectively. See the discussions regarding claims 2-4 and 7 above for the details of this disclosure.

Referring to claim 5, Klug discloses an integrated membership management center substantially as claimed. See Figures 1-8 and the corresponding portions of Klug's specification for this disclosure. In particular, Klug teaches an integrated membership management center [Registrar Web Site 100] that is connected to a plurality of service provision sites [Third Party Web Sites 116] and to at least one apparatus [WWW Client Node 108] via a network [WWW 104], the integrated membership management center comprising:

a searching unit [See step 800] searching and determining whether a record exists that coincides with new membership information that a user has used when the user has accessed one of the service provision sites to obtain access to the one of the service provision sites, from an apparatus [See claim 3]; and

a database [144] for registering the new membership information [User Registration Information] when the searching unit determines that the user is not registered in the database [See Figs. & 8 and Steps 424-432 (case in which user is registering with Registrar for the first time through a third party web site)] allowing a user to use the same user ID and password throughout the service provision sites [See Claim 1 above].

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Klug does not expressly state that the new membership information corresponds to an application for membership completed by a user at one of the service provision sites to obtain access to the one of the service provision sites as claimed. However, Klug's searching unit is specifically configured for determining if the user's registration information specific to a third party web site is different from / not present in the central database, and for registering this new information in the central database.

Hunt discloses a web registration system and method similar to that of Klug, wherein when a user is already registered at a third party web site ("an application for membership completed by a user at one of the service provision sites to obtain access to the one of the service provision sites"), the user's registration information is automatically transferred [See Step 302] to the central registration database [RAS] as claimed. See Figure 5 and the corresponding portion of Hunt's specification for this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Hunt's transfer capabilities to the system and method of Klug, for allowing the user to register at the third party web site and then transferring this new registration information to the central registration database, for example when Klug's search unit determines that registration information for the third party web site is different from, or not already present in, the central registration database [144] to obtain the invention as claimed. One would have been motivated to do so in order to allow the user to automatically transfer information already registered at a third party site to the central database without having to re-type this information at the central site, as disclosed by Hunt.

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Claim 6 is rejected on substantially the same basis as claim 3 above, in light of the basis for claim 5. See the discussions regarding claims 3 and 5 above for the details of this disclosure.

Claims 11-12 are rejected on substantially the same basis as claims 5-6 respectively. See the discussions regarding claims 5-6 above for the details of this disclosure.

Claim 14 is rejected on substantially the same basis as claims 5-6. See the discussions regarding claims 1-6 above for the details of this disclosure.

Response to Arguments

4. Applicant's arguments filed December 06, 2006 have been fully considered but they are not persuasive.

Applicant argues that Klug fails to disclose "a database held by an integrated membership management center and the user in Klug is not registering at a third party site first and then subsequently registering at the registration website.

Examiner respectfully disagrees. Examiner believes that Klug taught these features. Klug teaches the user's registration information is stored in the user's registration information database [see 144 of fig. 1; col. 4, lines 41-58]. Klug also teaches that the user accesses the third party web site and the third party web site responds with a registration fill-out form [see 404-432 of fig. 4A].

Applicant argued that Klug does not disclose "when a user makes an application for a registration of membership information at one of the service provision sites by using said apparatus, the one of the service provision sites receiving the application registers at least a part of the membership information into the database held by the one of the service provision sites,

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and when the user is not registered in the database held by the integrated membership management center, the integrated membership management center registers the membership information of the user into the database held by the integrated membership management center.”

The examiner disagrees for the following reasons: Again, applicant’s arguments are directed to a user being able to complete an application at a home page of a third party web site and have the application information transferred to the registration web site and stored. However, this is not claimed. The claim limitations do not require the sequence of operations being argued: that the user register at the third party web site (service provision site) and that the membership information is stored at the third party web site first; and then subsequently this membership information is transferred from the third party web site to the integrated membership management center for storage in the database of the integrated membership management center. In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies are not recited in rejected claims 1-4, 7-10 and 13. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner maintains that Klug anticipates the invention **as claimed**. Klug’s Figure 4 is clearly and explicitly directed to the case where a user is not yet registered at the Registrar web site, and registering his/her membership information for the first time. Klug’s Steps 404-408 clearly show a user “makes an application for a registration of membership information at one of the service provision sites by using said apparatus.” Note that “when a user makes an

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application for a registration of membership information at one of the service provision sites” in Steps 404-408 of Klug, the remaining claim limitations do in fact occur in Klug, as shown above. The sequence of events being argued by applicant are simply not required by the language of the claims.

Referring to applicant’s remarks on pages 9-10 regarding the Section 103 rejections of claims 5-6, 11-12 and 14: Applicant argued that Neither Klug nor Hunt recite “the integrated membership management center comprising a database registering the new membership information when the searching unit determines that the user is not registered in the database” as recited in claim 5.

The examiner disagrees for the following reasons: Applicant’s arguments attack the Hunt reference individually, but fail to consider the combination as a whole. In response to applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has failed to consider that in Figures 4 & 8 of Klug, the user is not yet registered at the Registrar site, but is currently attempting to do so. Regardless of whether or not Hunt’s user is already registered at the RAS site in the disclosure of Fig. 5, the fact remains that Hunt discloses automatic transfer of new membership information from a third party web site to the RAS for storage therein, so that the user does not have to repeat his/her efforts by registering the same information in multiple places. Applying this teaching to Klug, one of ordinary skill in the art at the time of applicant’s invention would have been motivated to add Hunt’s automated transfer of membership information already registered at a third party site

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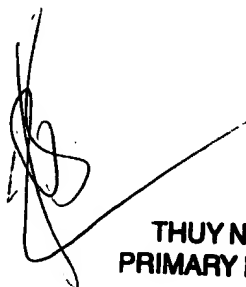
to Klug's central site, in the case where a user is not yet registered with the central site, but desires to be so. The motivation for this combination comes from Hunt, as described above, so that the user does not have to duplicate his/her efforts when the membership information is already registered at a third party site.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy N. Pardo whose telephone number is 571-272-4082. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 02, 2007



**THUY N. PARDO
PRIMARY EXAMINER**